

REMARKS

Claims 2-6 and 8-19 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 2, 3, 5, 6, 8, and 10-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leshar et al. (U.S. Pat. No. 4,604,933, hereinafter "Leshar") in view of Mattes (U.S. Pat. No. 4,137,808, hereinafter "Mattes"), and further in view of Kullmann et al. (U.S. Pat. No. 5,425,296, hereinafter "Kullman"). This rejection is respectfully traversed.

Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leshar in view of Morris et al. (U.S. Publ. No. 2002/0194974, hereinafter "Morris"). This rejection is respectfully traversed.

Claims 13 and 14

At the outset, Applicants respectfully reiterate the arguments previously presented regarding the failure of the combination of Leshar, Mattes, and Kullman to teach the recited features of claims 13 and 14. Applicants respectfully submit that the Examiner's reasoning for his rejection is unclear. Claim 13 specifically recites "a first edge surface generally parallel to an axis of rotation of the annular body and extending to a first end of said cutting edge and terminating at said first side." Claim 14 specifically recites "said cutting edge defined by a first edge surface extending generally perpendicular from and terminating at said first side of said body." The features quoted

above and recited in claims 13 and 14 clearly are not shown in Lesher. The Examiner fails to address these claim recitations in his rejection. Applicants assume that the Examiner contemplates some sort of combination of Lesher with Mattes and/or Kullman to form his rejection. Applicants respectfully submit that there is simply no motivation for the combination of references.

More specifically, Applicants note that any modifications to Lesher in view of Mattes are not properly motivated. "When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." MPEP §2142. The motivation to combine the references in the present action is not immediately apparent. The Examiner's explanation of the motivation for the combination is conclusory, merely stating that "it would have been obvious to combine Mattes with Lesher and Kullman for the purpose of reducing the pressure acting on each tooth during cutting."

However, this is not a proper motivation for a combination of the references, it is merely a recitation of the end result of a combination of the references. Applicants respectfully submit that the Examiner does not appear to have any objective reasoning for the combination other than his opinion that "it would have been obvious." The MPEP clearly states that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness" and that the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." MPEP §2143.01.

Applicants further reiterate the fact that Lesher and Kullman actually teach away from the proposed modification. Lesher clearly states that "all teeth 8, 9 as well as the

blade body 5 are symmetrical to a plane that is normal to the saw axis.” (col. 5, lines 23-24). Kullman similarly states that “[t]he design of each tooth 2 is designed symmetrically with respect to the longitudinal center plane 8, so that the phases 7 are provided symmetrically to the right and left of each tooth.” (col. 7, lines 16-19). Conversely, Mattes teaches non-symmetric teeth. Any modification of the teeth in Leshner and Kullman, as suggested by the Examiner, would teach away from the symmetric tooth structure set forth in the specifications of both Leshner and Kullman. Applicants note that the Examiner failed to address this argument in his “Response to Arguments,” and therefore, resubmit it for the Examiner’s consideration. This teaching away is specifically contrary to any suggestion or motivation indicated by the Examiner. As such, Applicants respectfully submit that claims 13 and 14 are in condition for allowance.

Claims 2-6 and 15-17 depend from claim 13 and claims 8-12 and 18 depend from claim 14, and therefore should be in condition for allowance for the reasons set forth above. Therefore, reconsideration and withdrawal of the rejection of claims 2-6 and 8-18 are respectfully requested.

Claim 2

In addition to the reasons set forth above regarding claim 13, Applicants submit that claim 2 is also not taught by the combination of Leshner, Mattes, and Kullman. In response to Applicants previous arguments, the Examiner now submits that:

Leshner teaches (see Figures 2, 3, and 5) an interface between the left cutting edge surface (24) and cutting edge surface (23) on a first insert (18) being closer to the left side of the blade body than an interface between the right cutting surface (37) and cutting edge surface (38) on a second insert (19) that is closer to the right side of the blade body than the interface previously described on the first insert (18).

Applicants respectfully submit that the Examiner is impermissibly picking and choosing among the elements of the various references.

Claim 13, from which claim 2 depends, specifically recites “a first edge surface generally parallel to an axis of rotation of the annular body and extending to a first end of said cutting edge and terminating at said first side.” This feature is clearly not shown in Figures 2, 3, and 5 of Leshner. Applicants respectfully submit that the Examiner’s reasoning for the rejection is unclear, as Leshner does not show this feature recited in claim 13. As indicated above, the Examiner appears to be combining Mattes with Leshner to create his rejection.

However, as previously indicated, as seen in Figures 4 and 5 of Mattes, if the junction of faces 10 and 14 in Figure 4 and the junction of faces 10a and 15 were considered the “interfaces” of claim 2, Mattes would teach away from the claimed limitations. The portions that might be considered “interfaces” in Mattes are located on alternating teeth, but are located closer to the same side for each of the alternating teeth. As such, Applicants respectfully submit that claim 2 is in condition for allowance for these reasons in addition to those set forth above regarding claim 13. Applicants respectfully request clarification of the rejection of claim 2 in view of Leshner if the Examiner is to maintain this rejection.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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